

REMARKS

In the Office Action dated May 27, 2005, claims 1-24 were presented for examination. The Examiner rejected claims 23 and 24 under 35 U.S.C. §§101 and 112, first paragraph. In addition, the Examiner rejected claims 1-22 and 23-24 under 35 U.S.C. §103(a).

Applicant wishes to thank the Examiner for the careful and thorough review and action on the merits in this application. The following remarks are provided in support of the pending claims and responsive to the Office Action of May 27, 2005 for the pending application.

I. Interview with Examiner Lu

On August 9, 2005 Applicant's Attorney had an interview with Examiner Lu to discuss the elements of the rejection presented in the Office Action dated May 27, 2005. Applicant's Attorney and Examiner Lu tried on several occasions to have Primary Examiner Ali present for the interview, but Examiner Ali could not arrange time in his schedule for the interview. Applicant's Attorney presented Examiner Lu with a proposed amendment to claim 23 in response to the rejection of claims 23 and 24 under 35 U.S.C. §§101 and 112. Examiner Lu indicated that the amendment should overcome these rejections. In addition, Applicant's Attorney and Examiner Lu discussed the rejection of claims 23 and 24 under 35 U.S.C. §103(a). Applicant's Attorney noted to Examiner Lu that this rejection borrows the *McGee et al.* patent to meet the mathematical formula placed in the body of the claim. However, as noted, *McGee et al.* does not teach the formula as claimed by Applicant. Examiner Lu agreed that the formula of Applicant is different than the formula disclosed in *McGee et al.*, but also indicated he did not have authority to allow the claim. Examiner Lu indicated he would discuss this element with Primary Examiner Ali.

II. Rejection of claims 23 and 24 under 35 U.S.C. §101

The Office Action of May 27, 2005 rejects claims 23 and 24 under 35 U.S.C. §101 indicating the claimed invention is not supported by either an asserted utility or a well

established utility. More specifically, the Office Action indicates that the parameters of the formula presented in claim 23 are not defined. Applicant has amended claim 23 to further define the elements of the formula presented herein. More specifically, the amendment to claim 23 defines each of the elements in the formula. The amendment presented herein was presented to Examiner Lu prior to the interview of August 9, 2005. Examiner Lu indicated the amendment to claim 23 would overcome the rejection presented herein. Accordingly, Applicant respectfully requests removal of the rejection of claims 23 and 24 under 35 U.S.C. §101.

III. Rejection of claims 23 and 24 under 35 U.S.C. §112, first paragraph

The Office Action of May 27, 2005 rejects claims 23 and 24 under 35 U.S.C. §112, first paragraph, indicating the claimed invention is not supported by either an asserted utility or a well established utility. Applicant has amended the preamble of claim 23 to a "computer implemented" method. Applicant's Attorney and Examiner Lu discussed this rejection on August 9, 2005, and Examiner Lu indicated this amendment to claim 23 would overcome this rejection. Accordingly, Applicant respectfully request removal of the rejection of claims 23 and 24 under 35 U.S.C. §112, first paragraph.

IV. Rejection of claims 1-22 under 35 U.S.C. §103(a)

The Office Action of May 27, 2005 rejects claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over *Tsutsumi et al.* (U.S. Patent No. 5,812,998) in view of *Singhal* (U.S. Patent No. 6,163,782). Applicant has canceled claims 1-22. Accordingly, the rejection set forth is now moot.

V. Rejection of claims 23 and 24 under 35 U.S.C. §103(a)

The Office Action of May 27, 2005 rejects claims 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over *Tsutsumi et al.* (U.S. Patent No. 5,812,998) in view of *Singhal* (U.S. Patent No. 6,163,782) and further in view of *McGee et al.* (U.S. Patent No. 6,496,228).

Applicant's remarks to *Tsutsumi et al.* and *Singhal* provided in the response to the First and Second Office Actions are hereby incorporated by reference.

With respect to claim 23, the Examiner combines *Tsutsumi et al.* with *Singhal* to teach all of the elements of the claim with the exception of the mathematical formula. The Examiner then borrows the *McGee et al.* patent to teach the elements of claim 23 pertaining to the mathematical formula. As noted by the Examiner, the combined teaching of *Singhal* and *Tsutsumi et al.* does not specifically teach assigning a standard proximity between the ranking of names in the first and second libraries. See Third Office Action, page 7. The Examiner then borrows *McGee et al.* to teach a formula for summing an absolute value of a difference between pairs of coefficients of current and previous frames. See Third Office Action, page 7.

However, the formula as taught in *McGee et al.* is not the same formula as claimed by Applicant. Applicant's claimed mathematical formula extends beyond the summation of the absolute difference between ranking of names in libraries. Applicant's formula includes a factor (1/n) associated with the quantity of names in the libraries. This factor is not present anywhere in *McGee et al.* "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Although it may be "obvious" to modify *McGee et al.* to incorporate the factor of Applicant (1/n), *McGee et al.* does not teach use of this factor associated with the summation of the absolute difference. The prior art must teach all of the elements in the claims. *McGee et al.* teaches use of a formula for summation of an absolute difference, but not a formula that implements a factor associated therewith based on the quantity of names in the libraries. If *McGee et al.* had wanted to use such a factor, then *McGee et al.* would have done so. The fact that *McGee et al.* does not use such a factor for the use claimed by Applicant should serve as evidence that *McGee et al.* does not teach or suggest this claimed limitation.

Furthermore, *McGee et al.* does not pertain to measuring proximity between a first library and a second library. The Examiner uses *McGee et al.* to support use of the mathematical formula. However, the *McGee et al.* patent does not pertain to the claimed subject matter,

namely measuring proximity between libraries. The Court of Appeals for the Federal Circuit has long held that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet that is the very process that the Examiner has undertaken. *McGee et al.* does not show, teach, or suggest implementing their mathematical formula for measuring proximity between libraries. Courts have long recognized that most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. The Court of Appeals for the Federal Circuit has stated that:

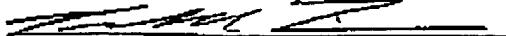
If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed invention would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’

In re Rouffet, 149 F. 3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (citing *Sensonics, Inc. Aerosonic Corp.*, 81 F.2d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)). In the present case, as one would naturally expect, the Examiner is finding some of the elements of Applicant’s invention in various prior art patents. However, the Examiner goes further in the present case by then using the Applicant’s claimed invention as a template to combine the elements found in the prior art in a way neither found in the prior art nor even functional in the prior art. It speaks to the novel nature of Applicant’s invention that when Applicant’s claimed invention is viewed in its entirety it is greater than the sum of its parts and combines to form an invention that produces an improvement over the prior art systems. Accordingly, the Applicant respectfully contends that the combination of *Tsutsumi et al.* in view of *Singhal* and further in view of *McGee et al.* does not, and can not, meet the standard set by the CAFC’s interpretation of 35 U.S.C. §103(a), and respectfully requests the removal of the rejection of claims 23-24.

For the reasons outlined above, withdrawal of the rejection of record and an allowance

of this application are respectfully requested.

Respectfully submitted,

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